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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,472	03/18/2004	Michael W. Diesch	026125-000200US	7248
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TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER LE, MICHAEL	
			ART UNIT 2163	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,472	Applicant(s) DIESCH ET AL.	
	Examiner Michael Le	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 30-36, 39-44, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 30-36, 39-44, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. In view of the pre-appeal conference request filed on July 16, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

2. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

3. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Summary and Status of Claims

4. Claims 1-28, 30-36, 39-44, 48 and 49 are pending.

5. Claims 30-33 are rejected under 35 U.S.C. 112, second paragraph.

6. Claims 30-33 are rejected under 35 U.S.C. 101.

7. Claims 1-28, 30-36, 39-44, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shutt (US Patent 7,146,367) in view of Fries (US Patent Pub 2003/0036922).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 30-33 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. **Claims 30-33** recite a computer-readable medium containing a program that performs a method. The claim then recites the steps of the method. The scope of claims 30-33 is unclear because it is not clear whether Applicant intends to claim a manufacture, in the form of a computer readable medium containing a program, or a method. In order to claim a computer readable medium containing a program that executes a method, the program must first be executed by a computer processor that causes the computer to perform the method.

11. The prior art rejections below for claims 30-33 are made as best understood in light of the 35 U.S.C. 112, second paragraph rejections addressed above.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claims 30-33 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

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14. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

15. In the present case, **claims 30-33** recite a computer readable medium containing a program, however the body of the claim is directed toward a method. As discussed above, it is unclear whether Applicant intends to claim a manufacture or a process. Accordingly, claims 30-33 cannot properly be categorized in one of the enumerated categories of invention. Therefore, claims 30-33 are nonstatutory.

16. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to overcome the rejection.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1-28, 30-36, 39-44, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shutt (US Patent 7,146,367) in view of Fries (US Patent Pub 2003/0036922).**

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19. In regards to **claim 1**, Shutt discloses a computerized method of searching property records relating to a specific parcel, the method comprising:

- a. receiving property record data for a plurality of parcels into a computer system (Shutt at col. 7, lines 32-7)¹, wherein the property record data relates to source property record documents (Shutt at col. 7, lines 53-9)² and wherein receiving property record data for a plurality of parcels into a computer system comprises:
 - i. receiving a plurality of images representing the property record documents (Shutt at col. 7, lines 53-9);
 - ii. converting the images to electronic image data (Shutt at col. 8, lines 34-9);
 - iii. paginating the electronic image data into related groups representing individual documents (Shutt at col. 8, lines 34-44);
 - iv. identifying a document type for each individual document (Shutt at col. 7, lines 56-9);
 - v. identifying data fields on each individual document (Shutt at col. 8, lines 34-44);
 - vi. using a combination of computer-implemented processes and manual processes to convert information in the data fields into electronic information (Shutt at col. 7, lines 53-67; col. 8, lines 34-44); and

¹ The documents are mortgage documents (see col. 5), which are received. Examiner interprets that mortgage documents correspond to parcels.

² The documents are scanned. The documents are interpreted as the source documents, while the scanned images are interpreted as the property record data.

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- vii. organizing the electronic information into property record data (Shutt at col. 8, lines 34-44)³;
 - b. storing the property record data in a searchable database (Shutt at col. 8, lines 55-60);
 - c. receiving into the computer system an identifier (Shutt at col. 8, lines 59-60);
 - d. in the computer system, using the identifier to search the property record data to select from the property record documents a set of relevant documents relating to the parcel (Shutt at col. 14, lines 34-46).
- 20. Shutt does not expressly disclose using the set of relevant documents to produce a data summary and outputting the data summary from the computer system, wherein the data summary comprises information from which an underwriter can underwrite a title policy, using commonly-accepted title policy underwriting rules, without reference to the source documents, or images thereof, from which the data summary originated.
- 21. Fries discloses an electronic title searching system and method for examining a title of a parcel. Fries at para. 0020, lines 1-2. Upon a query from a user, rules are used to search a database to review a title to determine a grade and ranking as well as liens, break in chain of title, etc. Fries at para. 0030. As a result, a summary of the information is given to the querying user. Fries at para. 0030.
- 22. Shutt and Fries are analogous art because they are directed to the same field of endeavor of property data storage and retrieval.

³ Indexing process is interpreted as organizing the electronic information into property record data

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23. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the method of Shutt by adding the steps of using the set of relevant documents to produce a data summary and outputting the data summary from the computer system, wherein the data summary comprises information from which an underwriter can underwrite a title policy, using commonly-accepted title policy underwriting rules, without reference to the source documents, or images thereof, from which the data summary originated, as taught by Fries.

24. The motivation for doing so would have been because electronic title examination is much more convenient, efficient and accurate. Therefore, storing property data, such as title information, in a database for searching and having the images available for retrieval if needed, is very useful. Fries at paras. 0006-0007.

25. In regards to **claim 2**, Shutt and Fries discloses the method of claim 1, wherein the title policy comprises a selection from the group consisting of (Fries at para. 0042):

- a. American Land Title Association (ALTA) Loan policy;
- b. ALTA Owner's policy;
- c. ALTA Short Form Residential Loan Policy;
- d. Homeowner's Policy of Title Insurance for a One-to-Four Family Residence;
- e. Standard Exceptions to the ALTA Loan Policy; and
- f. endorsements to an ALTA policy.

26. In regards to **claim 3**, Shutt and Fries discloses the method of claim 1, wherein the data summary comprises a display screen on a computer monitor. Shutt at col. 14, lines 34-6.

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27. In regards to **claim 4**, Shutt and Fries discloses the method of claim 1, wherein the data summary comprises a printed document. Fries at Fig. 7⁴.

28. In regards to **claim 5**, Shutt and Fries discloses the method of claim 4, wherein the printed document comprises a title abstract. Fries at para. 0020, lines 1-2.

29. In regards to **claim 6**, Shutt and Fries disclose the method of claim 5, wherein the title abstract is generated exclusively from the property record data. Fries at para. 0030.

30. In regards to **claim 7**, Shutt and Fries disclose the method of claim 4, wherein the printed document comprises a policy. Fries at para. 0029.

31. In regards to **claim 8**, Shutt and Fries disclose the method of claim 1, wherein the data summary comprises a stream of data directed to a second computer system that is different from the first computer system. Fries at para. 0043⁵.

32. In regards to **claim 9**, Shutt and Fries disclose the method of claim 8, further comprising thereafter using the stream of data to populate a document, wherein the document comprises a selection from the group consisting of: policy, deed, mortgage, commitment, closing-related document, template and form. Fries at para. 0042.

33. In regards to **claim 10**, Shutt and Fries disclose the method of claim 1, further comprising:

- a. creating at least one index relating the property record data (Shutt at col. 8, lines 34-5); and
- b. using the at least one index together with the identifier to select relevant documents. Shutt at col. 8, lines 55-60.

⁴ Examiner asserts that any results retrieved by a user can be printed.

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34. In regards to **claim 11**, Shutt and Fries disclose the method of claim 1, wherein using the identifier to search the database and select from the property record documents a set of relevant documents relating to the parcel comprises:

- a. in the computer system, using the identifier to search the database and select from the property record documents a set of potentially relevant documents relating to the parcel (Fries at para. 0034); and
- b. in the computer system, applying logic to organize the documents. Fries at para. 0037.

35. In regards to **claim 12**, Shutt and Fries disclose the method of claim 11, wherein applying logic to organize the document comprises:

- a. relating one or more documents to one or more other documents to identify any unreleased mortgages. Fries at para. 0030; para. 0037.

36. In regards to **claim 13**, Shutt and Fries disclose the method of claim 11, wherein applying logic to organize the documents comprises:

- a. relating one or more documents to one or more other documents to identify defective transfers. Fries at para. 0030; para. 0037.

37. In regards to **claim 14**, Shutt and Fries discloses the method of claim 11, wherein applying the logic to organize the documents comprises:

- a. relating one or more documents to one or more other documents to identify any unreleased liens. Fries at para. 0030; para. 0037.

⁵ The computer is networked. Searched can be performed over the network (i.e., stream of data).

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38. In regards to **claim 15**, Shutt and Fries discloses the method of claim 11, wherein applying logic to organize the documents comprises:

- a. relating one or more documents to one or more other documents to identify a good stop in a chain of title. Fries at para. 0030; para. 0037; para. 0042.

39. In regards to **claim 16**, Shutt and Fries discloses the method of claim 1, wherein relevant documents include:

- a. deeds, mortgages, assignments, loans, mortgage releases, lien releases, and tax assessor's reports. Fries at para. 0027; para. 0030.

40. In regards to **claim 17**, Shutt and Fries discloses the method of claim 1, wherein the property record data is received into the computer system before relevant document set is selected. Fries at para. 0020; para. 0034.

41. In regards to **claim 18**, Shutt and Fries discloses the method of claim 1, wherein the identifier comprises a selection from the group consisting of grantor name, legal description of the parcel, physical address of the parcel and a specific recorded document. Fries at para. 0030-0031

42. In regards to **claim 20**, Shutt and Fries discloses the method of claim 1, wherein the data summary comprises a listing of the relevant documents. Fries at para. 0042.

43. In regards to **claim 21**, Shutt and Fries disclose the method of claim 20, wherein the listing of the relevant documents includes a score for at least one of the documents that indicates the degree of relevant of the document. Fries at para. 0030.

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44. In regards to **claim 22**, Shutt and Fries disclose the method of claim 20, wherein the listing of the relevant documents comprises a hyperlink for at least one of the documents that returns an image of the document. Shutt at col. 8, lines 34-44.

45. In regards to **claim 23**, Shutt and Fries disclose the method of claim 1, wherein the data summary includes a score that provides an indication of the marketability of the parcel. Fries at para. 0030.

46. In regards to **claim 24**, Shutt and Fries disclose the method of claim 23, wherein the score comprises a grade. Fries at para. 0030.

47. **Claims 25-28** are essentially claims 1, 3, 4 and 8 respectively, in the form of a system and are rejected for the same reasons.

48. **Claims 30-33** are essentially claims 1, 10, 23 and 24 respectively, in the form of a computer readable medium and are rejected for the same reasons.

49. **Claim 34** is directed toward a method that is essentially the same as claim 1 but with broader scope. Therefore it is rejected for the same reasons as claim 1.

50. **Claims 35, 36 and 39-41** are essentially claims 8, 9 and 22-24 respectively and are rejected for the same reasons.

51. **Claim 42** is essentially the same as a combination of claims 1, 10, 21 and 22 and is therefore rejected for the same reasons.

52. **Claims 43, 44, 48 and 49** are essentially claims 8, 9, 23 and 24 and are rejected for the same reasons.

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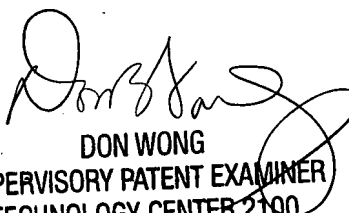
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Le
Art Unit 2163
October 29, 2007


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